

REMARKS

Favorable reconsideration of this application, in light of the preceding amendments and following remarks, is respectfully requested.

Claims 1, 3, 5, 7-9 and 14-17 are pending in the present application. Claim 4 is cancelled herein. Claims 1, 7, 14 and 17 are independent claims and have been amended. Claims 19-22 are added.

Claim Rejections under 35 U.S.C. § 103

Claims 1, 3, 5, 7-9 and 14-16 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Ueda et al. (U.S. Patent No. 6,289,102, herein Ueda). Applicants respectfully traverse this rejection as detailed below.

According to the new Examination Guidelines for Determining Obviousness under 35 U.S.C. § 103 in view of the Supreme Court decision of *KSR International, Co. v. Teleflex, Inc.* it is stated that the proper analysis for a determination of obviousness is whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts. The key to supporting to any rejection under 35 U.S.C. § 103 is the clear articulation of the reasons why the claimed invention would have been obvious. An Office Action must explain why the differences between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. The Guidelines further go on to recite seven rationales for making an obviousness determination. See 72 Fed. Reg. 57526, 57528-529 (Oct. 10, 2007).

Applicant respectfully asserts that a clear articulation of the reasoning of why the claimed invention would have been obvious has not been made. For example, with respect to claim 1 on pages 3 and 4 of the Office Action, it is stated that “Ueda does not disclose: wherein the physical address data has 24 columns and 6 rows, and the user control data has 24 columns and 24 rows.”

It is asserted that such a data structure would have been obvious to one of ordinary skill in the art at the time of the invention. It appears that the Office Action is making this assertion based on three theories.

First, it appears the Office Action is arguing that this limitation can easily be determined in the course of routine engineering optimization or experimentation. However, the Applicant respectfully sets forth that the MPEP in Section 2144.05, IIA, recites that in order of the optimization of a range to be obvious, it must be carved out from a range shown within the prior art.

In this case, Applicant respectfully asserts that the physical address data in columns and rows is not a range at all but an actual set amount of 24 columns and 6 rows for the physical address data and the user control data has 24 columns and 24 rows. Further, this has not been shown to be within a range in the prior art. Indeed, no prior art range has been set forth as required to show that the claimed range is a subset of a known range within a prior art range. See MPEP 2144.05. There has been no assertions of what ranges have been taught or suggested in the prior art for the limitations set forth in claim 1. Because the limitations set forth in claim 1 have not been shown to be a range (at all) or a range within a prior art range, a *prima facie* case of obviousness has not been made.

The second theory apparently asserted in the Office Action is the statement that absent a showing of criticality, i.e. an unobvious or unexpected results, the relationships set forth in this claim are considered to be within the level of ordinary skill in the art (see page 3 of the Office Action). However, other than this conclusory statement there has been no clear articulation of why claim 1 is considered to be within the level of ordinary skill in the art. Therefore, this sentence alone fails to be a clear articulation of the reasons why a claimed invention would have

been obvious as required by the new guidelines for showing obviousness. See 72 Fed. Reg. 57526, 57528-529.

The third argument apparently set forth in the Office Action is that it is asserted that the Applicant must show that the particular range is critical (generally by showing that the claimed range achieved unexpected results relative to the prior art ranges). Again, as set forth in the MPEP 2144.05 in describing obviousness of ranges, the initial condition must be met in that a prior art range must be laid out and it must be shown that the claimed range is within that prior art range. No base line prior art range has been shown, nor has it been shown the claimed range (if it even is a range) fits within the range within the prior art. Therefore, for this reason this argument fails to set forth a *prima facie* case of obviousness and does not set forth a clear articulation of the reasons why the claimed invention would have been obvious. Applicant respectfully notes that the same arguments apply to the other independent claims 7, 14, and 17, and thus applies to all the claims pending. For at least this reason, Applicant respectfully asserts that all of the claims pending in the application have not been shown to be obvious and therefore requests that the rejections under 35 U.S.C. § 103(a) be removed.

It is further noted that all of the independent claims have been amended to include an additional limitation. For example, claim 1 recites a high density computer readable medium including, among other things, "at least one false playback allowance code stored in the user control data for a playback-inhibited region, the at least one false playback allowance code being recorded with an optional value other than a value of said playback allowance code."

Applicant respectfully asserts that the claimed combination including the recited language quoted above is not shown taught or suggested in either Ueda or Reed either separately

or in combination. This limitation is similar to the one set forth in dependent claim 4 (now cancelled).

The Applicant acknowledges the Examiner's rejection of claim 4, for example, on page 8 and 9 of the Office Action. However, Applicant respectfully asserts that Ueda and Reed either separately or in combination do not teach or suggest all of the limitations set forth in now amended claim 1.

While it is true that the Reed reference does describe using decoy keys (see, for example, paragraph [0074]) nowhere is there a teaching or suggestion to associate those keys with a playback inhibited geographical region. While the Office Action on page 3 alleges that the Ueda reference teaches at least one playback allowance code which is adapted to determine region based allowance of playback of data recorded on the recording medium, nowhere in either Ueda nor Reed is there a teaching or suggestion of associating at least one false playback allowance code for a playback inhibited region. Rather, Reed just mentions decoy keys, it does not teach or suggest associating those decoy keys with a playback inhibited region. For at least these reasons, Applicant respectfully asserts that a *prima facie* case of obviousness has not been made. At least for these reasons, Applicant respectfully requests that the rejections under 35 U.S.C. § 103(a) of claim 1 and its pending dependent claims be allowed.

Applicant respectfully asserts that language similar to that discussed above with respect to claim 1 is also found in independent claims 7 and 14. Therefore, independent claims 7 and 14 are allowable at least for the reasons set forth above with respect to claim 1. Therefore, Applicant respectfully requests that the rejection of the pending claims 1, 3, 5, 7 through 9, and 14 through 16, be removed.

Claims 4 and 17 stand rejected under 35 U.S.C. 103(a) as unpatentable over Ueda et al. in view of Reed. Applicants respectfully traverse this rejection as detailed below.

Claim 4 has been cancelled and therefore this rejection is moot. Claim 17 contains language similar to that described above with respect to claim 1. Therefore, claim 17 is allowable at least for the reasons set forth above with respect to claim 1.

New Claims

Applicants have added claims 19 through 22 which are dependent upon claims 1, 7, 14, and 17 respectively. Applicant respectfully asserts that these claims are patentable at least by reason of their dependency and they are also patentable over the cited references in view of the limitations claimed therein.

CONCLUSION

Accordingly, in view of the above amendments and remarks, reconsideration of the objections and rejections and allowance of each of the pending claims of this application is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY, & PIERCE, P.L.C.

By:



Terry L. Clark, Reg. No. 32,644

Scott A. Elchert, Reg. No. 55,149

P.O. Box 8910
Reston, Virginia 20195
(703) 668-8000

TLC/SAE/PXL:eab

